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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,530	01/26/2001	Takahiro Miyoshi	010032	4911
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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			QIN, YIXING	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/769,530	Applicant(s) MIYOSHI ET AL.	
	Examiner Yixing Qin	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 recites the limitation "the monitoring program" in line 2 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 10, it is a dependent claim of claim 1, not claim 7, where a "monitoring program" is first mentioned. Appropriate correction is required.

Claim Rejections - 35 USC § 103

I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (U.S. Patent No. 6,791,703).

1. Claim 1 and claim 13

Regarding claim 1, Maeda discloses :

- a bookmarking technique to keep track of visited web pages that could possibly be printed. This is analogous to "a **print control number**." Maeda discloses in

Fig. 11 and column 10, lines 12-13, stating that “a bookmark is a list of URLs and the titles of the home pages.” From Fig. 11, one can see that each bookmark is assigned a number, starting with “1.”

- various print information in Fig 13, 14A, and 14B (“**print format information of a Web page that is provided from a WWW server**”). The various information displayed include paper size, duplex printing, and sorting among other functionalities.
- a web browser. In column 1, lines 18-14 Maeda states that “...a special software program (hereinafter referred to as a browser – i.e. “**a WWW browser through which the Web page is viewed and monitored**”) [is used] for accessing a server across a network, to use HTTP...to connect to a WWW server...”
- the transfer of print data from a computer to a digital copier. In Fig 1. and column 4 lines 53-55 by Maeda discloses that “...print data [is] received from an external device via the network 10a.” One of the external devices is a client computer (item 9 of Fig. 1). Although Maeda does not necessarily say that **the print data** is the **control number and print information**, it would have been obvious to one of ordinary skill in the art to send pertinent information to the printer.” The reason is so that the desired web page can be printed in the proper format. If this were not done, the printer would either not function or function improperly.

- the conversion of print data to a data type that can be understood by the digital copier (item 1 in Fig. 1 of Maeda). The digital copier is the focal point of Maeda's invention and can be interpreted as being a **"printer"** with added functionality. Thus, although most of the processing in Maeda's invention takes place in the various components of the digital copier and not necessarily the "printer" as claimed by the applicant, it would have been obvious to one of ordinary skill in the art to incorporate Maeda's various components into a printer as the exact positioning of the elements within the device is a matter of design.

Maeda does disclose in column 4, lines 53-56, by stating that "a formatter 6 (part of the digital copier or "printer", [is used] for converting print data (i.e. "data of the Web page") ...into a format that the digital copier 1 can print (i.e. "imaging data")." Furthermore, in column 5, lines 64-65, Maeda discloses that "...PDL data are developed into image data by the formatter 6..."

- the idea of a hard disk in the digital copier to store various information. In column 4, lines 48-50, by Maeda discloses that "a hard disk 3 (i.e. memory), [stores] image data ("**imaging data**"), various programs, and reference information ("**control number**")..." Although Maeda does not explicitly state that the control number or a "bookmark" as mentioned above is stored in the hard disk ("memory"), it would have been obvious to one of ordinary skill in the art to use the hard disk to store a "control number" as "reference information." The

motivation is to use storage (**hard disk or memory**) to keep track of relevant print information for future print jobs and it is conventional to store bookmarks on a computer's hard drive.

- The selection of a particular URL to print. Maeda discloses in Fig. 11 and column 10, lines 12-13, stating that "a bookmark is a list of URLs and the titles of the home pages." In addition, in column 10, lines 13-18, that "a desired URL is selected (i.e. to "**specify a specific data to print**).\" Furthermore, in Fig. 6 (item 604) and column 10, lines 65-67, a "Print button" is disclosed for the **execution of a print command** that sends the "setups" (user preferences from the print utility) to the digital copier.

Regarding claim 13, the program that executes the processes is the "print utility" (Maeda, column 6, lines 51-52). It is inherent that the program would be stored in some form of storage, whether it be RAM, a hard disk, a CD, etc. (i.e. **computer readable medium**)

2. Claim 2

Regarding Claim 2, Maeda discloses :

- a computer, printer and network interface. A "**computer and the printer are connected with each other through a local area network**" can be seen in Fig

1 and column 4, lines 54-55, by stating that "a network interface [is used] for communicating with an external device..." From Fig. 1, an external device can be the client computer (Fig. 1, item 9).

3. Claim 3

Regarding claim 3, Maeda discloses :

- the URL of a webpage. **"print information includes an address of the Web page..."** in Fig. 11. The bookmark in Fig. 11 is considered as having the control number (see claim 1 rejection above) and a location (i.e. "address") of the web page to be printed.
- the accessing of the web server to acquire data. Maeda discloses in column 6, lines 45-48, that "...the digital copier 1 accesses the WWW server 10 to obtain HTML data..." (i.e. **"printer accessing the Web page and obtaining the data of the Web page."**).

4. Claim 4

Regarding claim 4, Maeda discloses :

- the method of only printing updated web pages. Although does not explicitly disclose **"a step judging whether there has been an update in the data of the**

Web page", Maeda does teach in Fig 5B and column 9, lines 47-54 that the "(p)rint updated document only' 539 specifies whether only a home pages is updated after a previous printing should be printed..." Although it is not explicitly said that Maeda's invention has a certain step to do so, it is obvious that a check (i.e. **a judging step**) is needed to determine whether a webpage has been updated or not. The motivation would have been to print only newer, updated version of a web page.

- the notification of users of various information. Maeda does not explicitly teach **"notifying a user of the computer about the update if judging that there has been an update in the judging step."** However, Maeda does teach in several places that the user may be notified of not being registered (column 16, lines 1-2), permission of printing (column 16, lines 37-39), the maximum job count (column 16, lines 61-64), etc. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a notification for an updated webpage because it could be pertinent information the programmer of the print utility would want the user to know. The motivation would have been to give a user information regarding whether an updated webpage is being printed or not because a user may want to print out either an older version or the newer version of the web page.

5. Claim 6

Regarding claim 6, Maeda discloses :

- the idea of Web Pull Printing. Maeda discloses in column 6, lines 45-48, that “...the digital copier 1 accesses the WWW server 10 to obtain HTML data (i.e. “**printer receiving the data of the Web page** “)...is called a ‘Web Pull Print’...” Although Maeda does not explicitly teach that the **data is not in the memory** (or some other form of storage) in the printer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to only access data that is not already gathered. The motivation is to provide users with the ability to access data of pages that are not stored.

6. Claim 7

It is inherent that there would be a memory (or other storage device) for storing the browser and program and the reference shows using a hard drive to store data.

Regarding claim 7, Maeda discloses, in addition to those remarks made in claim 1 above, :

- a browser (i.e. “**a WWW browser.**”) Maeda teaches in column 1, lines 18-14 by stating that “...a special software program (hereinafter referred to as a browser) [is used] for accessing a server across a network, to use HTTP...to connect to a WWW server...”
- the idea of a print utility (i.e. “**a monitoring program.**”) Maeda teaches in column 6, lines 49-53, the concept of a “print utility” that resides on the client

computer that is used for "Web Pull Printing." The print utility is a program that has a variety of settings for the printing process including user name and password setting, HTML print options, HTML print style, Post Script Options, and scheduling of print jobs (see Maeda, Fig 5A-Fig12). It is also able to launch the bookmark feature as discussed in the claim 1 rejection above.

- the print utility has various functionalities to acquire information from a web page. (**"the monitoring program monitors a Web page, and creates a print control number and print format information of the Web page."**) Maeda discloses in Figs. 6 and column 9, lines 57-59, that Fig. 6 is the first screen that appears when the print utility (i.e. "monitoring program") is launched.

Furthermore, an "add bookmark button" (column 10, lines 18-22) can be used to add an URL to the bookmark list as mentioned in claim 1. Bookmarking effectively creates a number that is associated with an URL (see Fig. 11 of Maeda).

Furthermore, information as shown in Fig. 5A and 5B can be set using a "Print Setup" button (column 10, line 2). Information such as paper size, orientation, sorter, etc. (Fig. 5B) can be regarded as **"print format information."**

- a print utility (i.e. **"control portion"**) that sends information from a computer (i.e. **"print control number and the print format information"**) to the digital copier. Maeda discloses in column 10, lines 65-67 that "(w)hen the user...depresses the

'Print' button 604 on the operating screen in Fig. 6, the print utility transmits the setups to the digital copier." The print utility is on the client (i.e. "**computer**") as mentioned in the claim 7 rejection above. The "setups" are the various options that can be set as seen in Fig. 5A and 5B. The setups are received by the "formatter (Maeda, column 4, lines 53-56), (used) for converting print data...into a format that the digital copier 1 can print." On column 4, lines 57-60, Maeda discloses that there is a "...digital image printer (i.e. "**printer**")...and a core 2 for permitting (the) components to interact with each other."

7. Claim 8

Regarding claim 8, Maeda discloses, in addition to the remarks in claim 1 above, :

- the concept of an operation section ("**a control portion that accesses a Web page**"). Maeda teaches in Fig. 15 (item 331) and column 12, lines 25-29, that "... (t)he domain name of a WWW server to be accessed and the file name of the HTML data are to be obtained ("**obtains data**") are displayed in URL key 331 ("**an address of the Web page that is provided from outside**") ..." This technique is done in the "operation section" ("**control portion**") (Fig. 1, item 5), which needed to perform web pull printing in Maeda's system (column 6, lines 49-55).

Furthermore, in column 5, lines 64-67, Maeda discloses that "(t)he PDL data (which is one of the forms of data that could be acquired) are developed into image data by the formatter 6..." (i.e. **converts the data into imaging data.**)

- a hard disk (i.e. **a memory that stores the imaging data**). In column 4, lines 48-50, Maeda discloses that “a hard disk (i.e. “**memory**”) 3, [stores] image data...”
- a core, for data transfer and a printer for “**image-forming.**” The print utility provides the “**print execution command and the specific image data**” as discussed in the last limitation of claim 7 above. Maeda discloses in column 6, lines 10-14, that a “...core 2 can control the transmission of data among the [various components]...and can perform a compound process, such as the reading of a document, the printing of an image...” The **image forming portion** is disclosed in Fig. 1, item 8 as well as column 4, line 57 as “a digital image printer.”

8. Claim 9

Regarding claim 9, Maeda discloses :

- “A printing system comprising a computer, a printer, and a network that connects the computer and the printer.” Maeda discloses these components in Fig 1.
- the computer comprises:
 - a memory including a WWW browser and a monitoring program

- a control portion that is connected with the memory and operates according to the monitoring program,
 - the monitoring program monitors a Web page, and creates a print control number and print format information of the Web page
 - the control portion transmits print information including the print control number and the print format information created by the monitoring program to a printer connected with the computer,
- the printer comprises:
 - a control portion that accesses a Web page based upon an address of the Web page that is provided from outside, obtains data, and converts the data into imaging data
 - a memory that stores the imaging data
 - an image-forming portion that prints the imaging data in response to a print execution command that is provided from outside and specifies the imaging data.

For the rejections to the above limitations, please refer to the rejections made for claims 7 and 8 as claim 9 is a combination of the two.

Art Unit: 2622

II. Claims 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (U.S. Patent No. 6,791,703) in view of Hurwitz (U.S. Patent No. 6,256,669).

9. Claim 10

Regarding claim 10, the Maeda reference discloses all of the limitations of claim 10, except for the idea that an application displaying a specific file format in the www browser. Maeda discloses:

- a print utility ("**the monitoring program**") and a web browser ("**WWW browser**").

Maeda discloses in column 6, lines 51-53 that the "...print utility is operated by the external client 9." The program can be launched in synchronization with the browser if the user simply chooses to start both the browser and the print utility at the same time.

The secondary reference, Hurwitz discloses :

- various files types that can be displayed on a web browser using addition programs. Hurwitz teaches in column 1, lines 44-52, that certain file types "...require the Web browser to utilize additional programs or applications...(f)or example... postscript(.pdf)... audio(.ra)... and moving image(.qt) files (i.e. **file(s)** **displayed on the WWW browser by an application that is designed specifically for displaying the file and installed in the computer.**")

The Maeda reference disclosed a print utility ("**monitoring program**") that is able to access HTML data (Maeda, column 7, lines 13-17). Both the Maeda and Hurwitz references are pertaining to file data transfer using the Internet. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to improve Maeda's print utility by allowing it to access information from .pdf, .ra, and .qt (particular formats that require external "**applications designed specifically for displaying the files**" – Adobe Acrobat, Real Audio, Quicktime.). All three formats are well known in the art. The motivation is to be able to make the print utility ("monitor") more adaptable to different file data types for varying user needs.

10. Claim 11

Regarding claim 11, the Maeda reference discloses:

- that storing data and bookmarking web pages ("**a read-ahead printing**" technique) is possible. Maeda teaches in column 7, lines 13-17, that "...the domain name of the WWW server at which a home page to be printed is stored, as well as the file name of the HTML data that is to be obtained." This is one of the settings that a user may set in the print utility (as mentioned earlier).

Furthermore, the bookmarking feature as mentioned in claim 1 serves to choose a web page already visited for printing.

Maeda does not explicitly disclose:

- **“application-to-application configuration.”** However, it is implicit in the Maeda reference that a web browser(“**application**”) is configured to allow read ahead printing through the use of the bookmark feature as mentioned above.

Also, it is well known (Official Notice) that most applications (such as the “print utility”) allow users to set and configure the application (i.e. **set preferences**). The print utility acts as a program for the configuration of various printing settings (such as for read-ahead printing – see above limitation rejection) for the web browser (see Maeda Fig. 5A and 5B, which lists the “setups” that the print utility can set). It is thus implied that the print utility has put the web browser in the “ON” mode (as described in the application). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a preference to decide whether the print utility should access the web browser for read-ahead printing.

Furthermore, the secondary reference Hurwitz discloses that Adobe Acrobat, Real Audio, Quicktime (see claim 10 rejection above) can operate along with the web browser. The print utility can simply be configured to operate with Adobe Acrobat (to process PDF files along with HTML files from the web browser), and one of the preferences that the user can set would be whether to allow PDF or HTML access or both. Both the Maeda and Hurwitz references are pertaining to file data transfer using the Internet. Therefore it would have been obvious to one of ordinary skill in the art to allow the print utility to configure multiple programs (i.e. Adobe Acrobat, Real Audio, Quicktime) and to allow the

user to set which ones to access. The motivation is to allow users access to a wider variety of well known formats for printing.

11. Claim 12

Regarding claim 12, Maeda discloses:

- storing web page data and bookmarking (**“read-ahead printing”**). Maeda discloses HTML data saving and bookmarking techniques (please refer to the first part of the rejection for claim 11.)

Maeda does not explicitly disclose :

- **“configuration as to whether to carry out a read-ahead printing may be made for each file that the application opens.”** Again, this relates to the rejection made in claim 11 above. If the print utility can have preferences set to configure different applications, then it could have preferences to set the file types as well, especially if they are well-known file types such as .pdf, .ra, .qt (as disclosed by Hurwitz in column 1, lines 44-52 – see claim 10 above) and HTML or .txt files (as disclosed by the applicant.) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow the print utility (i.e. monitor”) to have access to various file types and allow a user to choose which file types to use for read ahead printing. The motivation is to allow users access to a wider variety of well known formats for printing.

Conclusion

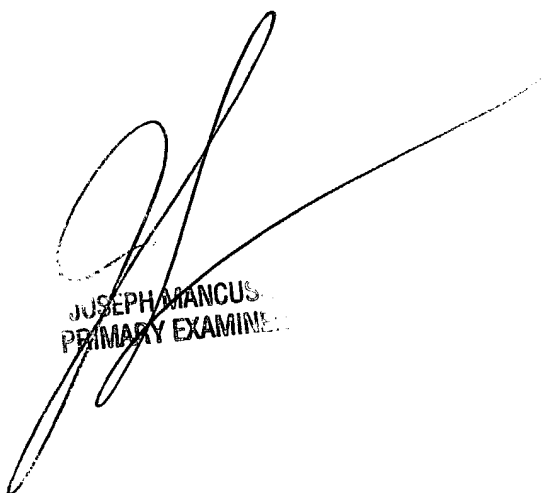
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is 703-306-4142.

The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ



JOSEPH MANCUS
PRIMARY EXAMINER